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| 10/757,229      | 01/14/2004  | Brandon Rogers       | DAY 0807 VA/40195.817 | 3259             |

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EXAMINER

SAN MARTIN, EDGARDO

ART UNIT

PAPER NUMBER

2837

DATE MAILED: 04/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/757,229

Applicant(s)

ROGERS ET AL.

Examiner

Edgardo San Martin

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 1 – 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mahl (US 3,998,347) in view of Caldwell et al. (US 3,160,549), and further in view of Gold (US 5,150,943).

With respect to claims 1 and 8, Mahl teaches a flexible polymeric material having a generally J-shaped configuration when viewed from an end thereof (Fig.2, Item 22), and having inner and outer surfaces, at least a portion of the inner surface of the J-shaped configuration including an adhesive thereon (Fig.5, Item 40) (Col.1, Line 60 – Col.2, Line 5, Col.2, Lines 37 – 40 and Lines 61 – 63), but fail to disclose wherein the strip of flexible polymeric material is used as a sound dampening pad, the generally J-shaped configuration being curved, the inner surface comprising the inner radius of the J-shaped configuration and the outer surface comprising the outer radius of the J-shaped configuration, and the adhesive is a pressure sensitive adhesive.

Nevertheless, Caldwell et al. teach a sound dampening member (Fig.1, Item 13) including a pressure sensitive adhesive (Fig.1, Item 11 and Fig.2) thereon, and wherein flexible polymeric material being used as sound dampening elements (Col.1, Line 11 – Col.3, Line 57). In addition, it has been held that a recitation with respect to the manner

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in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. Ex Parte Masham, 2 USPQ F.2d 1647 (1987).

On the other hand, Gold teaches a flexible polymeric material having a generally J-shaped configuration when viewed from an end thereof (Fig.3, Item 24), and having inner and outer surfaces, the inner surface comprising the inner radius of the J-shaped configuration and the outer surface comprising the outer radius of the J-shaped configuration, at least a portion of the surface of the J-shaped configuration including an adhesive thereon (Fig.3, Item 36) (Col.2, Lines 9 – 15 and 21 - 27); in addition, it has been held by the courts that a change in shape or configuration is nothing more than one of numerous shapes that one of ordinary skill in the art will find obvious to provide based on the suitability for the intended final application. See *In re Dailey*, 149 USPQ 47 (CCPA 1976).

It would have been obvious to a person with ordinary skill in the art at the time of the invention was made to employ the Caldwell et al. pressure sensitive adhesive and the Gold curved configuration with the Mahl flexible polymeric material design because the Caldwell et al. pressure sensitive adhesive it would provide the sound dampening pad with a ready-to-lay convenience that is easily applicable and well adapted for manual application, eliminating a time consuming application of an adhesive at the time of attachment to an element to be damped, the Gold curved configuration would provide a material that enables the strip to match, as required, the curved and bent shape of the element where the strip is going to be mounted.

With respect to claim 2, Mahl teaches flexible polymeric material strip comprises natural or synthetic rubber or a thermoplastic polymer (Col.2, Lines 37 - 40).

With respect to claims 3 - 5, Caldwell et al. teach in which the pressure sensitive adhesive comprises a double-sided adhesive tape (Fig.1; Col.2, Line 70 - Col.3, Line 30), in which the exposed surface of the double-sided adhesive tape includes a release liner (Fig.2, Item 23) thereon, and in which the double-sided adhesive tape includes a foam core (Fig.2, Item 21).

With respect to claims 6 and 7, Mahl teaches in which the adhesive is mounted on the longer leg (Fig.5, Item 24) of the J-shaped configuration, and in which the shorter leg of the J-shaped configuration has a length such that the shorter leg does not extend to the pressure sensitive adhesive (Fig.5; Col.2, Lines 61 – 63).

With respect to claim 9, Gold teaches wherein the curved configuration comprises a U-shaped configuration (Fig.3).

### ***Response to Arguments***

2. Applicant's arguments with respect to the claims have been considered but are moot in view of the new ground(s) of rejection. The Examiner considers that the obvious combination of the patents to Mahl, Caldwell et al. and Gold teach the limitations described in the claims, as discussed above.

***Conclusion***

3. The attached hereto PTO Form 892 lists prior art made of record that the Examiner considered it pertinent to applicant's disclosure.

***Contact Information***

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Edgardo San Martin whose telephone number is (571) 272-2074. The examiner can normally be reached on 8:00AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paula Bradley can be reached on (571) 272-2800 ext.33. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Edgardo San Martín  
Primary Examiner  
Art Unit 2837  
Class 181  
April 10, 2006